

REMARKS

Minor changes have been made to the specification. Claims 1 and 5-9 are amended, claims 10, 12-20 and 22-24 are cancelled and new claims 25 and 26 are added. Claims 1-9, 25 and 26 remain in the application. Re-examination and reconsideration of the application, as amended, are requested.

Claim 1 is rejected under 35 USC §112. This rejection is overcome in view of the amendment to claim 1.

Claims 1-24 are rejected under 35 USC §103 as being unpatentable over *Reilly et al.* (U.S. 5,740,549). However, claims 11 and 21 have been previously cancelled. This rejection is respectfully traversed on the grounds that the reference is defective in establishing a prima facie case of obviousness.

Independent claims 1, 25 and 26 include:

Claim 1. A method of tracking information provided to a computer system from a server, the method comprising:

- providing an identifier identifying the computer system, the identifier being imbedded in one of the computer hardware and firmware in the computer system;
- providing at least one database associating the identifier with information specific to a computer user associated with the computer system;
- logging onto one of an advertisement broker and a server;
- transmitting the identifier;
- requesting a banner advertisement be displayed on the computer system; and
- one of the advertisement broker and server transmitting an advertisement.

Claim 25. A method of tracking information to a computer system from a server comprising:

- providing an identifier for the computer system;
- providing a database associating the identifier with information specific to a computer user;
- logging onto a combination advertisement broker/server;
- transmitting the identifier and requesting a banner advertisement to be displayed;
- the database checking for the identifier;
- if the identifier is discovered, searching and identifying advertisements that match criteria provided by the user;
- if no matching criteria is found, the database transmitting one of generic advertisements and no advertisements;
- if the identifier is found, the user choosing to receive one of banner advertisements and not to participate;
- if the user elects to receive banner advertisements, storing the identifier; and displaying the advertisement.

Claim 26. A method for tracking information to a computer system from a server comprising:

- providing an identifier for the computer system;
- providing a database associating the identifier with information specific to a computer user;
- the server receiving a request for an advertisement from the computer user;
- transmitting the identifier to an advertisement broker;
- the broker logging the identifier in the database;
- the server transmitting an advertisement to the user; and
- the user transmitting a confirmation of receipt of the advertisement to the broker.

As the PTO recognizes in MPEP § 2142:

... The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the Examiner does not produce a *prima facie* case, the Applicant is under no obligation to submit evidence of nonobviousness...

In the present case, the reference does not provide all the limitations of the claimed invention. Thus, the rejection is improper because, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. In this context, 35 USC §103 provides that:

A patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the *subject matter* as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains ... (Emphasis added)

The Federal Circuit has held that a reference did not render the claimed combination *prima facie* obvious in *In re Fine*, 873 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988), because inter alia, the Examiner ignored a material, claimed, temperature limitation which was absent from the reference. In variant form, the Federal Circuit held in *In re Evanega*, 829 F.2d 1110, 4 USPQ2d 1249 (Fed. Cir. 1987), that there was want of *prima facie* obviousness in that:

The mere absence [from the reference] of an explicit requirement [of the claim] cannot reasonably be construed as an affirmative statement that [the requirement is in the reference].

In *Jones v. Hardy*, 727 F.2d 1524, 220 USPQ 1021 (Fed. Cir. 1984), the Federal Circuit reversed a district court holding of invalidity of patents and held that:

The "difference" may have seemed slight (as has often been the case with some of history's great inventions, e.g., the telephone) but it may also have been the key to success and advancement in the art resulting from the invention. Further, it is irrelevant in determining obviousness that all or all other aspects of the claim may have been well known in the art.

The Federal Circuit has also continually cautioned against myopic focus on the obviousness of the difference between the claimed invention and the prior art rather than on the obviousness *vel non* of the claimed invention as a whole relative to the prior art as §103 requires. See, e.g., *Hybritech Inc. v. Monoclonal Antibodies, Inc.* 802 F.2d 1367, 1383, 231 USPQ 81, 93 (Fed. Cir. 1986).

Because all the limitations of claims 1, 25 and 26 have not been met by the *Reilly et al.* patent, it is impossible to render the subject matter as a whole obvious. Thus the explicit terms of the statute have not been met and the Examiner has not borne the initial burden of factually supporting any *prima facie* conclusion of obviousness.

In view of the above, it is respectfully submitted that remaining claims are in condition for allowance. Accordingly, an early Notice of Allowance is courteously solicited.

Respectfully submitted,



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